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10/551,933

10/04/2005

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6475

210 7590 01/07/2009  
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EXAMINER

LOEWE, SUN JAE Y

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

01/07/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### **DETAILED ACTION**

1. Claims 8-14 and 22 are pending in the instant application.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 6, 2008 has been entered.

#### ***Response to Amendment***

3. The claim amendments filed on October 6, 2008 have been fully considered. The 35 USC 102 rejection has been obviated and is thus hereby withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

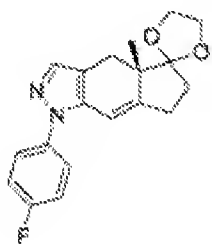
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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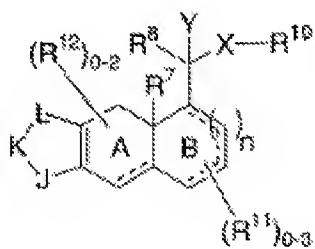
1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 8-10 and 22 rejected under 35 U.S.C. 103(a) as being obvious over a) Ali et al. (WO 04/075840; step 3 on p. 37, scheme 3 on p. 32, disclosure on p. 35-36); b) Ali et al. (WO 04/026248, step c on p. 39); c) Ali et al. (WO 2003/086294, step 3 on p. 43).

Determination of the scope and contents of prior art.

The references teach the compound shown below in a composition comprising 40 mL of acetic acid in 1 L of water (ie. aqueous solution).



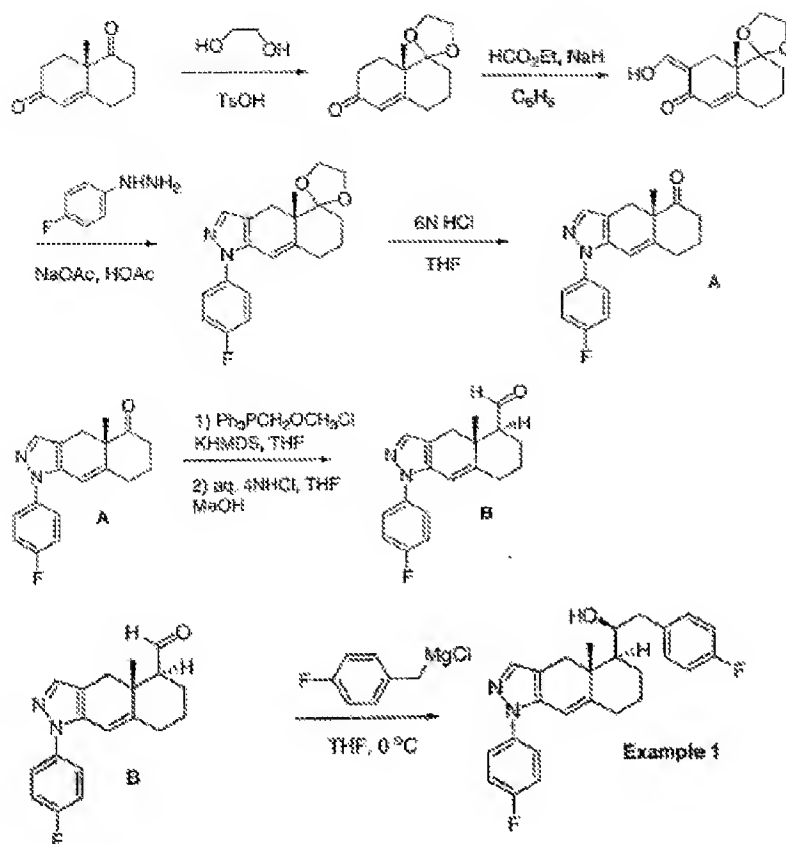
The compound is an intermediate in the synthesis of final product



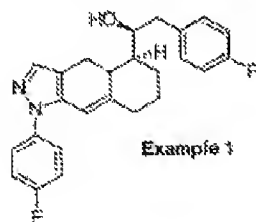
wherein R7 is hydrogen or alkyl (amongst other alternatives).

For example,

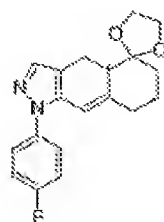
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Ascertaining the differences between prior art and instant claims.

The following generically taught modification to the prior art final product (ie. homolog)



results in the synthesis of a composition comprising



which is within the scope of the instant claims.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

To those skilled in chemical art, one homologue is not an advance over an adjacent member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of series, would know what properties to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lohr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963).

One of ordinary skill would be motivated, from the prior art disclosure – ie. generic teaching and the preferred embodiment - to make the modification required to arrive at the instant invention with reasonable expectation of success for obtaining an additional compound for the same utility. The motivation would be to make an additional glucocorticoid receptor modulators.

Thus, the instant claims are *prima facie* obvious over the teaching of the prior art.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe/

1-4-2008

/Golam M. M. Shameem/

Primary Examiner, Art Unit 1626